REMARKS

The Examiner has rejected Claims 10 – 12 under 35 U.S.C. 112, second paragraph as allegedly being indefinite. Specifically, the Examiner has alleged that Claims 10-12 depend on Claim 3, which has been cancelled. To remedy this, Applicants have amended Claim 10 to depend on Claims 4 or 14. Accordingly, the rejection is overcome and withdrawal thereof is respectfully requested.

Next, the Examiner has rejected Claims 7,8,9, and 13 under 35 U.S.C. 102(e) as allegedly being anticipated by Broom et al, U.S. Pat. No. 6,037,469 ("Broom et al.). In response, Applicants are amending claims 7, 8, 9, and 13 to recite an additional limitation of a solvent in an amount up to about 55% by total weight of the treatment material, wherein said solvent is selected from the group consisting of water, aliphatic hydrocarbons, aromatic hydrocarbons, alcohols, esters, glycol ethers, ketones, chlorinated solvents and glycols.

For a prior art reference to anticipate claims of a patent, it must expressly or inherently teach the entire claim. A prior art reference must be enabling before it can anticipate. That is, it must provide a description sufficient to teach a person of ordinary skill in the art how to make and use the apparatus or process. To qualify as an anticipatory reference, the reference must place the claimed invention in the possession of the public. Beckman Instruments, Inc. v. Produckter AB, 892 F.2d 1547, 1550, 13 USPQ2d 1301, 1304 (Fed.Cir. 1989).

Broom et al. do not disclose all the elements as recited in the newly amended Claims 7, 8, 9, and 13. Specifically, Broom et al. neither disclose nor enable the skilled artisan to make a treatment material for use in a method for removing a coating, said coating having a hazardous metal or compound contained therein having the claimed compounds and amount of solvent. This amendment is consistent with Applicants' previous amendment to Claim 4 made in

Applicants' Request for Continued Examination and Submission Pursuant to 37 CFR 1.114 on March 25, 2003. That previous amendment to Claim 4 resulted in the withdrawal of the rejection of Claim 4 under 35 U.S.C. 102(e). Since the Applicants have currently amended Claims 7, 8, 9, and 13 to recite the exact same limitation as recited in previously amended Claim 4, the Applicants respectfully submit that the rejection is similarly overcome, and therefore, withdrawal thereof is respectfully requested.

With respect to New Claim 15, that claim is largely the same as previously cancelled Claim 3. Previously cancelled Claim 3 was rejected as being allegedly anticipated by Broom et al. However, that rejection was improper since Broom et al. does not qualify as prior art under 35 U.S.C 102(e)(under both the pre and post American Inventors Protection Act.). The Examiner has alleged that the following version of 35 U.S.C. 102(e) applies:

> A person shall be entitled to a patent unless –
>
> > (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Under the above framework, Broom et al. cannot anticipate new Claim 15. First, new Claim 15 recites matter that originated in the specification of U.S. App. No. 08/322,252 filed October 12, 1994 to which this Continuation in Part claims priority. See Attachment A, which is the relevant portion of the 08/322,252 specification that supports Claim 15. On the other hand, Broom et al. 1) was not filed in the United States prior to October 12, 1994, the priority date of this application; and 2) is an international application that does not meet the requirements of paragraphs (1), (2), and (4) of Section 371(c) of Title 35. 35 U.S.C. 102(e). As shown in Attachment B hereto, Broom et al. has a Section 371 date and a Section 102(e) date of April 28,

1995 – more than six months *after* the filing date of U.S. App. No. 08/322,252, which is the application to which this application claims priority. Accordingly, Broom et al. cannot be applied as prior art to Claim 15 rendering Claim 15 in condition for allowance.

Finally, the Examiner has rejected Claims 4 – 6, and 14 under 35 U.S.C. 103(a) as being allegedly unpatentable over Broom et al. Here to, Broom et al. cannot qualify as prior art since it is nonanalogous. Binding Federal Circuit case law provides the Examiner with the relevant test for determining whether a particular reference is appropriate and analogous. That test is to 1) determine whether the references is "within the field of the inventor's endeavor"; and 2) assuming the reference is outside that field, to determine whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); see also In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). The Federal Court cautions that in determining the appropriateness of applying a reference, "prior art may not be gathered with the claimed invention in mind." Pentec, Inc. v Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (again the Federal Circuit is indicating that using hindsight is impermissible).

Applying the first prong of the Federal Circuit's test, Broom et al. is nonanalogous art since it is not within the field of the inventors' endeavor. The field of the endeavor of the inventor is recited in the specifications as:

> a **composition and method for removing coatings containing hazardous metals or organic material from the surface of metals and non-metals** and, in particular, compositions for use with methods for removing such coatings and rendering the removal material a non-hazardous waste byproduct and minimizing the exposure of the waste byproduct to the environment. Additionally, the **invention relates to the application of treatment materials to wastes that are to be disposed of with the hazardous coating intact**.

See Specification, page 1 (emphasis added). Thus, the field of the Applicants' endeavor in this application speaks for itself.

The field of the inventor's endeavor in Broom et al., however, is quite different. The inventors in Broom et al. were quite clearly in the field of pharmaceutical compositions and more specifically, chemical compounds that have beta-lactamase inhibitory and antibacterial properties – which are fields widely divergent from the field of the Applicants' endeavor. Thus, the fist prong of the Federal Circuit's test in In re Deminski is satisfied.

With Broom et al. outside the field of the inventors' endeavor, the Federal Circuit directs the Examiner to the next inquiry, which is whether either reference is reasonably pertinent to the particular problem with which the inventors of claimed invention are involved – clearly Broom et al. is not. To illustrate, the object of the claimed invention is to allow for the stripping and safe disposal of coating containing hazardous materials. Broom et al., in marked contrast, is not directed to this problem. Rather, Broom et al. is directed to problems that were quite different than those faced by the inventor of the present invention, for example, providing a compound useful in the "treatment of infections in animals, especially mammals, including humans, in particular humans and domesticated farm animals." *See Broom et al, Col. 10, Lines 1-13.* To be sure, these are not the types of problems that faced the inventor of the claimed invention. Therefore, the inventor of the claimed invention could not be expected to look to Broom et al. for providing a teaching relevant to the *pertinent problems* before him. "A reference is reasonably *pertinent* if ... it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the problem." Wang Labs., Inc . v. Toshiba Corp., 993 F.2d 858 (Fed. Cir. 1993). Because of the widely divergent aims of Applicant with that of the inventors of Broom et al., Applicant respectfully submits that Broom

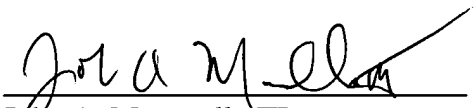
et al. would not have "commended itself to [the] [Applicant's] attention in considering the problem ." Wang Labs, Inc., 933 F.2d 858. Accordingly, Broom et al. is nonanalogous art. Respectfully, the only way Broom et al. could have been gathered and applied as a reference would have been with the claimed invention in mind. In other words, hindsight was employed in applying Broom et al. And employing hindsight is impermissible. Pentec, Inc. v Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) (the Federal Circuit is indicating that using hindsight is impermissible).

Accordingly, the rejections based on obviousness with respect to Broom et al. should be withdrawn.

Applicants respectfully submit that the Claims are in condition for allowance and respectfully request the same.

Applicant would appreciate the courtesy of a telephone call should the Examiner have any questions or comments with respect to this response or the claim language for purposes of efficiently resolving same.

Respectfully submitted,

By 

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PRESENTLY PREFERRED EMBODIMENTS

The presently preferred embodiment of the invention comprises applying to the surface coating to be removed a treatment layer made up of at least one compound selected from the group comprising:

Sodium Silicate	Diammonium Phosphate
Sodium Metasilicate	Diacalcium Phosphate
Sodium Orthosilicate	Dipotassium Phosphate
Potassium Silicate	Tricalcium Phosphate
Aluminum Sulfate	Trisodium Phosphate
Alum	Sodium Metabisulfite
Ferrous Sulfate	Metallic Iron
Ferric Sulfate	Silcate of Soda
Tricalcium Silicate	Soda Ash (Sodium Carbonate)
Dicalcium Silicate	Caustic Potash (Potassium)
Tricalcium Aluminate	Hydroxide)

and an alkaline metal salt such as aluminum, ferrous or other metal carbonate, silicate or bicarbonate. The ratios of first compound to alkaline metal salt is normally dependent upon the coating to be removed. Set forth below is an illustrative example of a preferred treatment process.

Example:

A. Preferably, 3 oz of standard tap water or 3 oz of Sodium Silicate (Grade 42 Ratio 3.23). This is the preferred binder for the treatment layer which is used to bond together the components and to attach the treatment layer to the surface that is to have coating removed. There are different grades and ratios or sodium silicate and the set time can differ considerably between them. Thus, the grade to be used depends on what needs to be accomplished on the surface, e.g., chemicals to dry or to stay moist. It also depends on the type of blasting or removal equipment is to be used.

Attachment B

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UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

5602250

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6-(substituted methylene)penems and intermediates

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